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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/685,138	10/11/2000	Ju-Heon Lee	P56181	4552

8439 7590 10/29/2003

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EXAMINER

HUYNH, KIM NGOC

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 10/29/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/685,138

Applicant(s)

LEE, JU-HEON

Examiner

Kim Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8 and 16-32 is/are pending in the application.
- 4a) Of the above claim(s) 1,2,4-8,21-24 and 30-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-20 and 25-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. The applicant pointed out that claims 3 and 12-15 were canceled. The examiner agrees, the examiner also would like to point out that group I recited to include claims **21-24** instead of **12-24** as indicated by the applicant.

Under the principles of compact prosecution, the examiner incorporates the following restriction to provide a correction to the previous restriction requirements and to include the claims as amended in the amendment filed 9/3/03 (Paper No. 10).

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-2, 4-11, and 21-24 drawn to a peripheral configuration of portable memory device, classified in class 710, subclass 8.
- II. Claims 16-20 and 25-30, drawn to the method of input/output access regulation, classified in class 710, subclass 36 (previously recited as group III).
- III. Claim 31 links the inventions of group II and I.
- IV. Claim 32 links the inventions of group I and II.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of

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using that product (MPEP § 806.05(h)). In the instant case the method of invention II does not require the cover protecting of the USB device to carry out the process of expanding the memory or securing the hard disk.

Claims 31 and 32 link(s) inventions I and II. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claims 31 and 32. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. This application also contains claims directed to the following patentably distinct species of the claimed invention:

Species 1, Figs. 1A-1B, directed to a memory device with a hole;

Species 2, Figs. 2A-2C, directed to the cover of the memory device;

Species 3, Figs. 3 and 4A-4B, directed to the connection between a USB memory device and a USB supporting computer;

Species 4, Fig. 5, directed to the circuit configuration of a USB memory device;

Species 5, Fig. 6, directed to the operation steps of a USB memory device used as a portable memory medium;

Species 6, Fig. 7, directed to the operation steps of a USB memory device used as a security key.

5. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

6. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

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7. Applicant's election with traverse of group II (previously recited as group III), species 6 with traverse in Paper No. 10 is acknowledged. The traversal is on the ground(s) that the inventions of groups I and II pertains to both the structure of the USB memory stick and method using the USB memory stick and are no need for separate classification. This is not found persuasive because the USB connector cover with auto sliding backward is not required in group II, the method of using the USB memory stick and the security code verification process of group II is not required by the structure of the USB memory stick of group I.

As for the traversal of Species requirement, please note 37 C.F.R. 1.142 states that the restriction requirement will normally be made before any action on the merits; however, it may be made at any time before final action.

Claims 31 and 32 link(s) inventions I and II. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claims 31 and 32. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In*

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re Ziegler, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

For the above reasons, the requirement is still deemed proper and is therefore made FINAL.

8. Since applicant did not identify a listing of all claims readable thereon the species that is elected consonant with this requirement. The examiner, under the principles of compact prosecution, has identify group II (originally group III), species 6 claims as elected by the applicant in paper no. 10 to be claims 16-20 and 25-29. Please note claims 30 and 31 do not pertain to species 6, the operation of a USB memory device used as a security key, as elected by applicant.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 16-20 and 25-29 are rejected under 35 U.S.C. 103(a) as being obvious over Goren (US 6,317,836) in view of Sartore et al. (US 6,012,103) and applicant's admitted prior art (APA).

Claim 16, Goren discloses computer system for securing a host computer system having steps of determining if a device (key 42) is connected to the computer 30 upon powering up (during POST), and enabling the hard disk drive of the host computer if

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security information of the device matched with the security information store in the memory 36 of the host computer (see at least col. 6, ll. 15-19, col. 7, ll. 6-24 and Fig. 7). Though Goren does not specifically disclose the key 42 being a USB device, however, Goren disclose the key can be connected to serial port, mouse port, or a joystick port, therefore the key would be a serial device. Please note that both applicant and Sartore both recognize that USB is the new emerging technology providing easier, more reliable, and single standardized peripheral device connection system to eliminate the need for multiple connectors and cables (Statore, col. 1, ll. 33-45 and APA, background). It would have been obvious to one having ordinary skill in the art to utilize USB connector and therefore the key 42 as a USB device to provide easier, more reliable, and single standardized peripheral device connection system of the USB technology as widely recognized.

Claim 17-18 and 26-29, Goren discloses step of performing power on self-test when power is applied to the computer and booting host computer by an operating system after enabling the hard-disk drive only when the passwords matched (POST, col. 4, l. 53 through col. 5, l. 35, col. 6, ll. 60-63).

Claims 19-20 and 25, please note that the method steps of Goren displaying error message when the device is not attached and when the security code does not match (Fig. 7, S58).

Conclusion

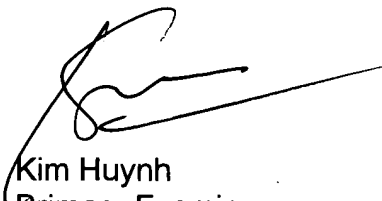
11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wang et al. (US 6,618,807) discloses an electronic key for

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storing password. Parzych et al. (US 5,375,243) and Miller (US 6,038,320) disclose hard-disk password security systems for verifying the password prior to booting the hard-disk.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Huynh whose telephone number is (703) 308-1678.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



Kim Huynh
Primary Examiner
Art Unit 2182

KH
October 17, 2003